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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,581	06/24/2003	Gary Balakoff	44904.000736	8202

21967 7590 12/14/2004

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT PAPER NUMBER

1772

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/601,581

Applicant(s)

BALAKOFF ET AL.

Examiner

Christopher P Bruenjes

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1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20040102.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitation that the first side "does not have an adhesive coating" renders the claim vague and indefinite. It is not understood if this limitation refers to the first side not having an adhesive coating applied to it or if the first side itself is not an adhesive coating. Furthermore, it is not understood, without further defining what is considered an adhesive, how the first side can adhere to a textured surface but not be an adhesive, since the broadest interpretation of adhesive is a substance tending to adhere or promotes adhesion.

Claims 2-13 are rejected as being dependent on claim 1.

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**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 1-4 and 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gotoh et al (USPN 5,286,781) in view of Harvie et al (USPN 5,693,405).

Gotoh et al teach a masking or surface protective film (col.1, 1.20-23) comprising a first side and second side. The first side is a smooth surface and does not have an additional adhesive coating added to it. The first side comprises

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hydrogenated styrene-isoprene-styrene block copolymer, which is styrene-ethylene/propylene-styrene, or hydrogenated styrene-butadiene-styrene, which is styrene-ethylene/butylene-styrene, or hydrogenated styrene-isoprene, which is styrene-ethylene/propylene, or hydrogenated styrene-butadiene, which is styrene-ethylene/butylene (col.3, 1.51-60). The first side further comprises 10-200 parts by weight per 100 parts by weight of the block copolymer of tackifying resin (col.4, 1.8-10) and 25-200 parts by weight per 100 parts by weight of the block copolymer of flexible polyolefins (col.4, 1.40-42). The flexible polyolefins are ethylene, polypropylene, or acrylate-modified polyethylenes (col.4, 1.17-24). The masking film comprises at least two co-extruded layers (col.5, 1.37-41). Specific examples of the proportions of the three components are shown in examples 3-5 with the hydrogenated SIS or SBS forming between 42% and 56% of the layer, and the tackifying resin forming between 28% and 43% of the layer (col.7, 1.45 - col.8, 1.18). Because the first side is formed from the same composition as the claimed invention and made by the same co-extrusion process and the properties of the same composition must be the same, the first side is inherently capable of removably adhering to a textured surface having a surface

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roughness in the range of from about 150 to 1000 Ra such as the surfaces claimed in claims 12 and 13.

Gotoh et al fail to explicitly teach forming the second side with a rough surface. However, Harvie et al teach the second side of a masking or surface protective film is matte embossed so that the film does not block on a roll or wrinkle during winding. The patterned embossed side of the film traps a quantity of air between wound layers of film as the film is being wound onto the roll. This air entrapment also facilitates the wrinkle-free unwinding of the film from the roll as it is being applied to a substrate (col.2, 1.24-30). Unembossed portions are applied to the second side to form a pattern decoration in order to provide brand identification and/or written marketing, instructional or advertising material (col.2, 1.56-61). One of ordinary skill in the art would have recognized that the second side of a masking or surface protective film is matte embossed in a pattern with embossed and unembossed areas, so that the film does not block on a roll or wrinkle during winding and in order to provide brand identification and/or written marketing, instructional or advertising material, as taught by Harvie et al.

Regarding claim 10, Harvie teaches that one or more layers of the film include a pigment such that the matte portions

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appear different than the glossy unembossed portions, in order for ready visualization of the pattern (col.7, 1.3-12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to matte emboss the second side of the masking film of Gotoh et al, so that the film does not block on a roll or wrinkle during winding, the matte embossment is formed in a pattern of embossed and unembossed areas in order to provide brand identification and/or written marketing, instructional or advertising material, and one or more of the layers of the film include a pigment in order to improve visualization of the pattern, as taught by Harvie et al.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gotoh et al in view of Harvie et al as applied to claim 1 above, and further in view of Okumura et al (USPN 6,407,788).

Gotoh et al in view of Harvie et al teach all that is claimed in claim 1, but fail to explicitly teach adding an anti-static additive to the masking or surface protective film. However, Okumura et al teach that in certain uses, such as protecting a display surface of a liquid crystal display, a masking or surface protective film is subjected to an antistatic

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treatment. The antistatic treatment comprises adding an antistatic agent or additive to the adhesive layer and/or polymer layer, or forming an antistatic layer under the adhesive layer and/or the back coating layer (col.2, 1.33-55). One of ordinary skill in the art would have recognized that Gotoh et al, Harvie et al, and Okumura et al are combinable since each of the aforementioned references are analogous insofar as being directed at masking or surface protection films.

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add an anti-static agent or additive to the film of Gotoh et al and Harvie et al, in order to provide the film with antistatic properties which are needed in certain uses of a masking or surface protection film, such as protecting a display surface of a liquid crystal display, as taught by Okumura et al.

#### **Conclusion**

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ghiam et al (USPN 6,040,046); Ogawa et al (USPN 6,391,974); Sumi (USPN 6,582,789).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to



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Christopher P Bruenjes whose telephone number is 571-272-1489.


The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB  
December 7, 2004

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

12/10/04